

REMARKS

In this submission, the above listing of the claims replaces all prior versions, and listings, of claims in the application. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Claim Status

Claims 1-19 stand provisionally rejected for double patenting; and

Claims 1-19 stand rejected under 35 USC § 103.

Claim Amendments

In this response, the claims have been amended in a manner which improves the clarity with which the claimed subject matter is set forth. The amendments to claims 1 and 19, make it clear that the network address is detected at the printer, the message requesting authorization is sent from the printer and a document which is imported from a network address is merged at the printer.

In other words, the present invention is directed to what can be considered to as a "smart" printer which is capable of performing a number of different operations within its own right.

Double Patenting

It is again submitted that the Applicant is willing to consider the filing of a terminal disclaimer, however still wishes to wait until either this application or one of copending applications listed in the previous response, issues. This will establish which applications will be terminally disclosed with respect to which. In the interim, the double patenting rejection is provisionally traversed for at least the reason that it is not yet determined what the exact scope of the claims of each application will be at the time of their respective allowance. The double patenting rejection is also traversed in that the claims of this and the other two applications have been amended in a manner which is deemed to overcome the rejection.

Rejections under 35 USC § 103

- 1) The rejection of claims 1-10, 13-14 and 18-19 under 35 USC § 103(a) as being unpatentable over Tabata et al. in view of Russell et al., is respectfully traversed.

In the instant rejection it is asserted that:

. . . Tabata discloses a printing method comprising receiving printing stream data (which reads on image data from medium form 420) at a printer (470B) (column 23, lines 56-63).

On page 6 of this action it is stated:

“the Examiner has never submitted that the printer performs functions of the scanner.”

If this last statement is true, then the only rational interpretation of the above first three lines of the rejection pertaining to claims 1, 6 and 19, is that - the scanner scans the medium form 420 and produces print stream data which is supplied to the printer.

That is to say, column 23, lines 56-63 reads:

Then, the **medium form 420** with the mark(s) 51 added thereto is read by the **scanner unit** (correlated information identifying unit) 430 or 470A (S2101). In this case, **each of the scanner units 430, 470A reads a code area 206 from the medium form 420** as raster information and also reads a text section with the mark(s) 51 added thereto. With those operations, linkage information and selection information are supposed to be read. (Emphasis added)

As will be noted, there is no printer 470B mentioned. In fact, it explicitly stated that the scanner units **read** from the medium form 420.

Nevertheless, the rejection dead ends at the printer of Tabata et al. in that the requirements of the claims as amended in this response are neither disclosed nor rendered obvious.

At this point, Applicant's submit that as the rejection is made under the § 103 statute, the test is therefore what the hypothetical person of ordinary skill would understand to be disclosed in the Tabata et al. reference when taken as a whole. It is submitted that the burden is on the PTO to demonstrate this understanding clearly and explicitly and set forth on the record how it would be derived. At this time, there are tenuous issues wherein integration of a printer and a scanner into a single unit are blurring the PTO's position and are such as to render the record unclear.

More specifically, in connection with the statement:

"the Examiner has never submitted that the printer performs functions of the scanner",

attention is called to page 6 of the office action dated 04/28/2004, wherein in the last two lines of the second paragraph, it is stated:

"since the scanner and printer units are integrated into one unit, it is obvious that the copier (**or printer 470**) reads the information." (Emphasis added)

*(Note the clear inference that the printer "reads.")*

The above statement follows the statement that:

"it is erroneous for the applicant to conveniently disregard Tabata's disclosure and state that irrespective of integration, the scanner and the printer are different devices."

*(This was made in response to Applicant's position that even though the scanner and the printer are disposed in the same box (viz., housing) they remain functionally different)*

However, it is then contradictorily stated that:

“additionally, it is notoriously well known to persons of ordinary skill in the art that a **copier** comprises a **scanner to read a document** and a printer to print the images.”  
(Emphasis added)

*(Note this reinforces Applicant's position)*

The Examiner has therefore correctly asserted on the record that the scanner and printer are integrated into one unit – a copier - and that copiers comprise a scanner to read and a printer to print – and then for all intents and purposes, incorrectly and contradictorily inferred that the printer can “read”.

It therefore appears that the position which is being taken for the sake of rejection is that - if the copier reads the information then the “printer” reads the information (apparently, in the absence of any clarification to the contrary, performing the function of the scanner).

(Note the reinforcing statement in this office action -  
“copier (or **printer 470**) **reads** the information.” )

It would be reasonable to generalize that the copier (as a whole) reads information because it includes a scanner. However, it is irrational to take the position that because the printer is integrated into the copier, the printer (despite the presence of the scanner) can be *per se* taken as reading the information. Irrational, unless the printer is being held to perform functions of the scanner.

In this response, claims 1 and 9 have been amended to require that the merging operation be carried out at the printer. There is nothing in Tabata et al. which would suggest this, and the disclosure at the cited column 30, line 46 – column 32 line 19, & column 24, lines 24-49, is submitted to devoid of any suggestion of the same.

In this rejection it is also stated that Tabata et al. does not clearly disclose requesting authorization from a user entity to access the network address. To overcome this admitted shortcoming, Russell et al. is cited with a specific cite to column

19, line 55 to column 20, line 6. However, this section of Russell et al, disclose that a user is required to manually enter a preassigned access code.

This disclosure cannot possibly suggest the claimed limitation that: if a network address is detected, then displaying or sending a message, from the printer notifying a user entity of the network address detection and requesting authorization from the user entity to access the network address. That is to say, the printers in both Tabata et al. and Russell et al. are terminal devices are not disclosed as being equipped with anything that might allow a message to be sent therefrom and most certainly nothing that would enable a message requesting authorization to access the network.

- 2) The rejection of claims 11 and 12 under 35 USC § 103(a) as being unpatentable over Tabata et al. in view of Russell et al and further in view of Wolff, is respectfully traversed.

Claim 1 calls for receiving print stream data at a printer. Claim 11 calls for the receiving data step to comprises receiving an e-mail containing the data. To receive e-mail at a printer is beyond any possible suggestion that can be gleaned by the hypothetical person of ordinary skill from any of the three references applied in this rejection. Indeed, Wolff has been cited only to overcome the admitted shortcoming that overall system of Tabata et al. does not disclose/suggest the receipt of data via e-mail and therefore is not cited as teaching anything else.

This rejection is clearly untenable.

- 3) The rejection of claims 15-17 under 35 USC § 103(a) as being unpatentable over Tabata et al. in view of Russell et al and further in view of Wolff, is respectfully traversed.

In this rejection, Wolff has been cited solely to overcome the admitted shortcoming that Tabata et al. does not disclose printing one document in another and identifying the contents of the documents. This rejection is untenable - Wolff in fact fails to suggest printing one document in another and can be relied upon only to suggest that different documents can be obtained and an image of each of the documents be generated – see the steps disclosed in Fig. 4. There is definitely no

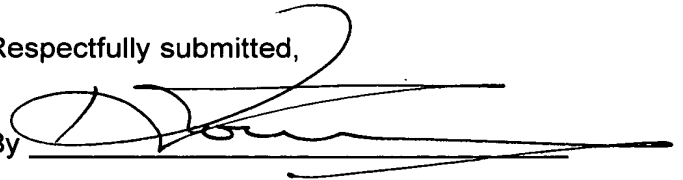
disclosure of merging two different documents at the printer and therefore no disclosure of printing one document in another in the manner now required by the claims.

Conclusion

It is submitted that the claims are allowable over the art for at least the reasons advanced above. Favorable reconsideration and allowance of the claimed subject matter is courteously solicited.

Respectfully submitted,

By

A handwritten signature in black ink, appearing to read 'W. T. Ellis', written over a horizontal line.

Date: December 28, 2004

HEWLETT-PACKARD COMPANY  
Customer No.: 022879

William T. Ellis  
Registration No. 26,874

Keith J. Townsend  
Registration No. 40,358